



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,667	09/26/2001	Mark Thompson	020375-003500US	2848

20350 7590 08/29/2003

TOWNSEND AND TOWNSEND AND CREW, LLP  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834

EXAMINER

PATEL, JAGDISH

ART UNIT	PAPER NUMBER
----------	--------------

3624

DATE MAILED: 08/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/965,667	THOMPSON, MARK
	Examiner	Art Unit JAGDISH N-PATEL 3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1)  Responsive to communication(s) filed on 06 May 2003.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4)  Claim(s) 1-7 and 9-23 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-7 and 9-23 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## **Application Papers**

- 9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_ .  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ . 6)  Other: \_\_\_\_\_

**DETAILED ACTION**

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.
2. This office action is responsive to amendment filed May 6, 2003 (paper No. 8) and issued as a first office action on merit because of introduction of new ground of rejection not necessitated by the applicant's amendment.
3. The after final amendment is not entered.
4. Claims 1-7 and 9-23 are currently pending and have been examined.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. Claims 1-23 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential

Art Unit: 3624

steps, such omission amounting to a gap between the steps.

See MPEP § 2172.01. The omitted steps are explained as follows:

8. Claim 1 recites limitation "recording by the provider computer, collection of cost from the customer..", however, the claim fails to recite any communication link of the customer (e.g. via a customer computer) to the provider computer and receipt of the cost of the goods by the customer prior to recording of the cost (received) from the customer. Additionally, there is no communication link between the merchant (e.g. a merchant computer) and communication of indication of the delivery of the goods by the merchant communicated to the provider computer before, the authorizing step is performed.

Since, the receiving, recording and authorizing steps are performed by the provider computer, and since these steps require information from the customer and the merchant, a communication link and requisite communication of information amongst all three entities must be clearly recited.

Claims 2-7 and 9-12 inherit same defects as dependent claims. Independent claims 13 and 23 (and dependent claims)

Art Unit: 3624

contain similar deficiency as claims 1-7 and 9-12 discussed above and are rejected accordingly.

**Claim Rejections - 35 USC § 102**

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claim 1-11, 13-18 and 23 are rejected under 35

U.S.C. 102(e) as being clearly anticipated by Haseltine

(PGPUB-DOCUMENT-NUMBER: 20010037247) (hereafter

Haseltine).

Per claim 1, Haseltine discloses a method for managing a transaction for a sale of goods between a customer (buyer) and a merchant (seller) (abstract), the method comprising:

Receiving by a provider computer affiliated with a plurality of provider offices, a communication relating to the transaction that includes a cost of the goods ([0059] buyer 50 pays the service 40..affiliated provider offices are point-of-sale offices 42);

Recording, by the provider computer, collection of the cost from the customer at one of the plurality of provider offices in accordance with the communication (para [0059] or else pays a point-of-access associate which the customer

Art Unit: 3624

finds nearby, ... service 40 is providing services in the nature of escrow by holding buyer's payment until buyer is afforded an opportunity to inspect item);

Authorizing payment, by the provider computer, of the cost to the merchant after the merchant delivers the goods ([0059] If the item 551 is taken, then the service 40 releases or causes release of payment to the seller 50.sup.1.]).

Claim 2: cost from the customer..cost of goods plus a service charge.. (.. other detailed of the transaction.. who pays shipping, fees of the service 40 and its point-of-access associates 42.., para [0056] and for additional details also refer to[0060]).

Claim 3: recording collection of a portion of the cost plus service charge ..and recording collecting remainder of the cost plus service charge (.. other detailed of the transaction.. who pays shipping, fees of the service 40 and its point-of-access associates 42.., para [0056] and for additional details also refer to[0060]).

Claim 4-5: customer and merchant are located in a different country (Haseltine provides for both the customers (buyer 22) and the merchants (E-tailer) have access of the system via the Internet which reaches all users in the world, therefore this limitation is inherent, refer to Figure, 1, block 16 shows communication network e.g. Internet, Web by all entities of the claims).

Art Unit: 3624

Claim 6: refer to analysis of claim 1.

Claim 7: goods are delivered by the merchant to the one of the plurality of provider offices ([0059] buyer can visit point of access 42b.. inspect item there..].

Claim 8: cancelled.

Claim 9-10: authorizing, by the provider computer, release of goods to the customer after recording collection of cost from the customer and authorizing delivery by the provider computer (para [0059] the service 40 is providing services in the nature of escrow by holding buyer's payment...).

Claim 11: providing a hyperlink to a web site of the merchant (para [002] and [004] and Fig. 1, refer to block 40 who provides services to affiliated E-tailers via web and/or the Internet).

Claim 13 and 23 are analyzed as per corresponding method claim 1 which recite corresponding limitations.

Claim 14: refer to claim 5 analysis.

Claim 15: refer to claim 11 analysis.

Claim 16: refer to claim 3 analysis.

Claim 17: refer to claim 2 analysis.

Claim 18: refer to claims 7 and 9.

Claim 24: refer to claim 5 analysis.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 12 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haseltine.

Claim 12: Haseltine fails to teach that the provider computer determines shipment of the goods as a part of an aggregate shipment.

Official is notice is taken that aggregating goods for shipment is old and well known business practice. It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to implement this process because aggregating goods (such as according to geographic address of the customer etc.) would reduce cost of shipment.

Claims 19-21: Haseltine fails to teach service charge and currency exchange as recited.

Official is notice is taken that including shipping and insurance cost to the service charge and further performing currency transaction are old and well known business practices in sales and specifically in e-commerce

Art Unit: 3624

transactions. It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to implement these features as desired and needed by the merchant which would enable the merchant to sales in a desirable foreign currencies.

Claim 22: refer to claim 12 analysis.

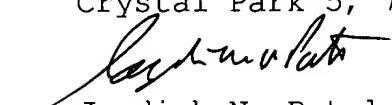
***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038. The fax number for Formal or Official faxes to Technology Center 3600 is (703) 305-7687. Draft faxes may be submitted directly to the examiner at (703) 746-5563.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 308-1114. Address for hand delivery is 2451 Crystal Drive, Crystal Park 5, 7<sup>th</sup> Floor, Alexandria VA 22202.

  
Jagdish N. Patel

(Examiner, AU 3624)

8/27/03